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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/731,267

12/08/2003

Wesley H. Smith

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EXAMINER

WOO, STELLA L

ART UNIT

PAPER NUMBER

2643

DATE MAILED: 01/31/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/731,267

Applicant(s)

SMITH, WESLEY H.

Examiner

Stella L. Woo

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– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 03/08/04; 04/11/05.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

2. Claims 1, 3-4, 8, 10, 12, 14-15, 17, 19, 21, 23, 25, 27 are rejected under 35 U.S.C. 102(e) as being anticipated by Green (US 6,920,207).

Regarding claims 1, 8, 12, 17, 21, 25, Green discloses a method comprising:

transmitting data from an electronic system over a communications medium (modem 120 communicates with server modem 160 over telephone line 140; Figure 1A; col. 1, line 66 – col. 2, line 12);

receiving an indication of an incoming telephone call transmitted over the communication medium (user receives a call waiting signal when an incoming call is received from third party terminal 170; col. 1, lines 21-24; col. 3, lines 14-16); and

maintaining the data session while halting the data transmission (the server modem 160 goes on hold when the user accepts the call using telephone 110; col. 3, lines 11-15).

Regarding claims 3, 8, 14, the data session is maintained using the v.92 modem on hold feature (col. 1, lines 19-24; col. 1, line 66 – col. 2, line 1), and voice communication takes place via the speaker and microphone of the handset of telephone 110 (Figure 1A).

Regarding claims 4, 10, 15, 19, 23, 27, data transmission is resumed upon termination of the incoming telephone call (Figure 4, steps 420, 430, 460; col. 3, line 20 – col. 4, line 11).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary

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skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 2, 5, 9, 11, 13, 16, 18, 20, 22, 24, 26, 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Green in view of Velius (US 5,594,784).

Green differs from claims 2, 5, 9, 11, 13, 16, 18, 20, 22, 24, 26, 28 in that it does not teach accepting or terminating an incoming call by voice command. However, Velius teaches the desirability of allowing a call recipient to accept, refuse and terminate a call by voice command (col. 7, lines 34-45) such that it would have been obvious to an artisan of ordinary skill to incorporate such use of voice command, as taught by Velius, within the system of Green in order to provide the user with totally hand-free voice telephone communication.

5. Claims 6-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Green in view of Olafsson et al. (US 6,912,276 B1, hereinafter "Olafsson").

Green differs from claims 6-7 in that it does not teach indicating the source of the incoming call. However, Olafsson, from the same field of endeavor, teaches the desirability of indicating caller ID information when notifying a user of an incoming call during a modem session (col. 5, lines 24-45) such that it would have been obvious to an artisan of ordinary skill to incorporate the reception of caller ID information, as taught by Olafsson, within the system of Green so that a user can better decide whether or not to interrupt his data session by accepting an incoming call.

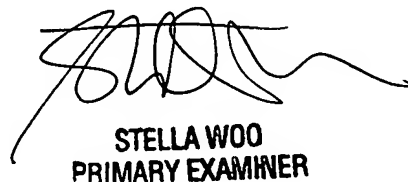
Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Chan et al. and Zhang et al. show answering a telephone call by voice command. Kerner et al. show another modem on hold system.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stella L. Woo whose telephone number is (571) 272-7512. The examiner can normally be reached on Monday-Tuesday, Thursday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Curtis Kuntz can be reached on (571) 272-7499. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



STELLA WOO
PRIMARY EXAMINER